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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,900	08/20/2001	Claudia Dorenkamp	LNUP:105_US_	8067
7590 03/17/2004			EXAMINER	
Hodgson Russ LLP Intellectual Property Law Group One M & T Plaza Suite 2000 Buffalo, NY 14203-2391			ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 03/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	Application No. 09/932,900	Applicant(s) DORENKAMP ET AL.	
	Examiner Lyle A Alexander	Art Unit 1743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>082001</u> | 6) <input type="checkbox"/> Other: ____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6,9-13,18-25, 28-32 and 39-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heid et al.

Heid et al. teach an automated apparatus(1) for treating cytological or histological specimens. Column 3 lines 8+ describe the apparatus(1) as computer controlled for automatically running stored and selected treatment programs. The programs provide instructed a transport device to move the samples to individual treatment stations, remove the sample after the appropriate residence time and transport to the next/new treatment station. Each treatment station is selected according to the specific computer program required. The computer control can be set up for the simultaneous, parallel

course of different and/or like treatment programs. The apparatus has a housing(1a) with two openings(4,5) that act as loading or unloading stations. The computer processor(31), memory(32), display field(2) and keyboard(3) are all integrated with the apparatus(1). A basket with specimen holder baskets is inserted is inserted into the loading station and acts as a transport unit taking the sample to the appropriate treatment station (column 4 lines 1+). The treatments stations(6a-j) are arranged in a two dimensional array. Two horizontal guides(8a-b) facilitate sample transport to the treatment stations(6a-j). The transport device(33-36) has four drives and via interface cards(33-36) the exact position of transport device is known at all times.

The claimed "multiple processing stations" have been read on the taught treatment stations(6a-j) and the claimed "transport device" on the taught transport devices(33-36). Heid et al. teach each treatment station is selected according to the specific computer program and has been read on the claimed "specific function".

Heid et al. teach specific placement of the treatment stations and interface cards(33-36) that define these locations of the treatment stations and permit controlled access to each station. Column 5 lines 9-12 teach the air can be evacuated from housing(1a) .

The claimed "robotic arm having a gripper located ..." has been read on the taught two horizontal linear guides(8a-b), movable cross bar(9), vertical guide(10) and movable slider(11).

Claims 1-6,9-13,18-25, 28-32 and 39-43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Thiem et al. (USP 6,635,225).

Thiem et al. teach an automated apparatus for the cytological/histological staining of tissue samples comprising a transport basket(4) containing multiple slides(2), reagent containers(3), transport mechanism(6), transporting arms(24), sensors(12) and control/logic circuits(24/25). This has been read on the claimed multiple modular processing stations and transport device to move the sample in and out of the processing stations.

Claims 1-6,9-13,18-25, 28-32 and 39-43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Theim et al. (USP 6,080,365).

Thiem et al. teach an automated apparatus(1) for the cytological/histological staining of tissue samples comprising a plurality of chemical containers(4), turntable(7), a central guide rod(8) with an electrical slip ring(25) power connector that facilitates suction means to evacuate the housing(3), and an object holders(6) to move the slides about within the apparatus(1). This has been read on the claimed multiple modular processing stations and transport device to move the sample in and out of the processing stations.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8, 14-15, 26-27 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heid et al., Theim et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225).

See Heid et al., Theim et al. (USP 6,080,365) and Thiem et al. (USP 6,635,225) *supra*.

The art is silent to the claimed attachment of the processing stations by bolts or clamped by a bracket, indication of a sample in the loading station by acoustically or

optically means and a loading station in the form of draw that automatically opens and closes.

The court decided In re Boesch (205 USPQ 215) that optimization of a result variable is ordinarily within the skill of the art. A result effective variable is one that has predictable and well known effects.

Bolts and clamping brackets are known for their attachment capabilities and are result effective variables. Clamps and bolt attachment further have the advantage of being removable as opposed to welding which is not removable. Finally, bolts and clamps are advantageous because the layperson is familiar with their function. It would have been within the skill of the art to modify Heid et al., Theim et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) and use bolts or a clamping bracket to attach the processing stations as optimization of a result effective variable and to gain the above advantages.

Indication of a position being occupied by an optical means, such as a flashing light, or by an acoustic means is a well known result effective variable with the effect of notifying the technician of the status of sample. Optical and acoustic indicators have the further advantage of being universally recognized and are not bound by language barriers. It would have been within the skill of the art to further modify Heid et al., Theim et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) and use optical or acoustic means to indicate a sample has been loaded as optimization of a result effective variable and to gain the above advantages.

Claims 16-17 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heid et al., Theim et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) in view of Champseix et al. (USP 5,578,268).

Heid et al., Theim et al. (USP 6,080,365) and Thiem et al. (USP 6,635,225) *supra*.

The art is silent to the claimed motor actuated drawers as a loading station.

Champseix et al. teach a device for sample transfer and analysis the includes a mobile drawer(72) that aids in sample engagement/discharge. Drawers would be further advantageous because the sample loading station can be retracted which minimizes the size of the apparatus and streamlines the device reducing accidents/damage from collisions.

It would have been within the skill of the art to modify Heid et al., Theim et al. (USP 6,080,365) or Thiem et al. (USP 6,635,225) in view of Champseix et al. to include the sample loading station in the form of a motor actuate drawer to gain the above advantages.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43, 1-32, 1-26 and 1-28 of copending Applications No. 09/932,900, 09/793,199, 10/011,674 and 09/932,889 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a similar histological apparatus having multiple processing stations, a transport device, loading station and a removal station. The limitations of 7-8, 14-17, 26-27 and 33-38 would have been obvious and within the skill of the art as discussed in the above 35 USC 103 rejections.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
Art Unit 1743